

PATENT
APPLICATION 09/843,289
ATTORNEY DOCKET 2005P12928US (1120-005)

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 46, 58, 75, 81, and 85 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 25-100 are now pending in this application. Each of claims 25, 46, 58, 75, and 81 are in independent form.

I. The Obviousness Rejections

Each of claims 25-100 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations U.S. Patent No. 6,346,964 ("Rogers"), U.S. Patent No. 5,941,951 ("Day"), U.S. Patent No. 6,324,163 ("Alexanders"), "Techniques for Improving the Capacity of Video on Demand" ("Kalva"), U.S. Patent No. 6,011,782 ("DeSimone"), and/or U.S. Patent No. 5,903,559 ("Acharya"). Each of these rejections is respectfully traversed.

A. Legal Standards

1. Prima Facie Criteria for an Obviousness Rejection

Over 40 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and

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4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*'s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The United States Supreme Court clarified the obviousness inquiry criteria in *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). The KSR Court held:

1. "[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art";
2. "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art";
3. it is necessary "to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit"; and
4. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006).

In order to establish a *prima facie* case of obviousness, certain criteria must be met. Evidence must be provided that indicates that the combination was obvious to a person with ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). There must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. In addition, the prior art reference (or references when combined) must teach... all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

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Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, reh'g denied, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." See, *In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (quoting *In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. Claim Construction

Before the *prima facie* obviousness criteria can be applied, the words of each claim must be interpreted. The Federal Circuit, in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (*en banc*), cert. denied, 546 U.S. 1170, 126 S.Ct. 1332, 164 L.Ed.2d 49 (2006) has clarified that:

1. "[t]he Patent and Trademark Office ('PTO') determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction 'in light of the specification as it would be interpreted by one of ordinary skill in the art'" (*Id.* at 1316);
2. the words of a claim "are generally given their ordinary and customary meaning" (*Id.* at 1312);
3. the ordinary and customary meaning of a claim term is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application" (*Id.* at 1313);
4. "the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification" (*Id.*);

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5. even "the context in which a term is used in the asserted claim can be highly instructive" (*Id.* at 1314);
6. "the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs" (*Id.* at 1316);
7. even "when guidance is not provided in explicit definitional format, the specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents" (*Id.* at 1321);
8. an "invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office" (*Id.* at 1317 (*citing Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966))); and
9. the "prosecution history... consists of the complete record of the proceedings before the PTO and includes the prior art cited during the examination of the patent" (*Id.* at 1317).

The rules established in *Phillips* apply to *ex parte* examination in the USPTO. *See, In re Kumar*, 418 F.2d 1361 (Fed. Cir. 2005).

3. All Words in a Claim Must Be Considered

"To establish *prima facie* obviousness..., '[a]ll words in a claim must be considered'". MPEP 2143.03, quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see also, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

4. Inherency

Inherency "requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295, 63 USPQ2d 1597, 1599 (Fed. Cir. 2002).

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5. Unfounded Assertions of Knowledge

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

6. Lack of Evidence of Reasons for Combining References

Under the *Graham* analysis, the “examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP 2142. The requirements for meeting this burden are clear.

To factually support a *prima facie* conclusion of obviousness, an Office Action must provide evidence that indicates that the combination was obvious to a person with ordinary skill in the art. The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007) (quoting *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

7. Reasonable Expectation of Success

If all the limitations of a claim are found in a combination of prior art references, “a proper analysis under § 103 requires, *inter alia*, consideration of ... whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success” *Medichem, S.A. v. Rolabo, S.L.* (Fed. Cir. February 3, 2006) (quoting *Velander v. Garner*, 348 F.3d 1359, 1363 (Fed. Cir. 2003) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966))).

“[T]o have a reasonable expectation of success, one must be motivated to do more than merely to ‘vary all parameters or try each of numerous possible choices until one possibly

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arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful.” *Medichem, S.A. v. Rolabo, S.L.* (Fed. Cir. February 3, 2006) (quoting *In re O’Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988)). “Similarly, prior art fails to provide the requisite ‘reasonable expectation’ of success where it teaches merely to pursue a ‘general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.” *Id.*

B. Analysis

1. Claim 25

a. Inherency

The present Office Action states, regarding Rogers, that “receiving from a subscriber unit a request for a list of available channels (programs), the request including information identifying a subscriber (fig. 7a, step 701, the identity of the subscriber is inherent in the request so that the server could be able to send back a list of available program-emphasis added).” *See*, Page 3. No evidence has been presented that the admittedly “missing descriptive material is ‘necessarily present’” in Rogers. Applicant respectfully requests provision of evidence supporting the assertion that “receiving from a subscriber unit a request for a list of available channels (programs), the request including information identifying a subscriber (fig. 7a, step 701, the identity of the subscriber is inherent in the request so that the server could be able to send back a list of available program-emphasis added).”

To the extent that the present Office Action or any future Office Action intends to rely on inherency to support a claim rejection, Applicant respectfully traverses, respectfully requests provision of proper evidence supporting such rejection, and respectfully requests a detailed explanation of how the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to support such rejection.

b. Prima Facie Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

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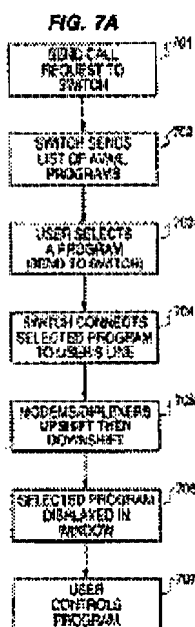
c. Missing Claim Limitations

Claim 25, from which each of claims 26-45 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "receiving from a subscriber unit a request for a **list of available channels**". The present Office Action alleges that Rogers teaches this claimed subject matter at col. 12, lines 45-48. Yet this applied portion of Rogers states, "[r]eferring briefly to FIG. 4, if the user has selected a television broadcast, this would include the step of controlling the TV tuner board 464 to tune to the selected channel". Applicant respectfully submits that the present Office Action presents no substantial evidence that this applied portion of Rogers teaches an "list of available channels" whatsoever. Thus, no substantial evidence is presented that the applied portions of Rogers teach, "receiving from a subscriber unit a request for a **list of available channels**".

The applied portions of Day fail to cure at least these deficiencies of the applied portions of Rogers.

Claim 25, from which each of claims 26-45 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "sending to the subscriber unit a response to the received request with an indication of the identified channels, the response being sent using HTTP protocol and **identifying the IP multicast group assigned to each identified channel**". The present Office Action alleges that this claimed subject matter is taught by Rogers at "fig. 7a, step 702". Yet Fig. 7a of Rogers merely illustrates:

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Applicant respectfully submits that step 702 merely discloses "switch sends list of available programs". The present Office Action presents no substantial evidence that this applied portion of Rogers teaches:

- i. "sending" anything to the "subscriber unit" in "response to" any received request";
- ii. any "indication of the identified channels" as one having ordinary skill in the art would interpret the claim term "channels";
- iii. any "response" whatsoever "sent using HTTP protocol"; or
- iv. "identifying the IP multicast group assigned to each identified channel"

Consequently, the present Office Action presents no substantial evidence that this applied portion of Rogers teaches, "sending to the subscriber unit a response to the received request with an indication of the identified channels, the response being sent using HTTP protocol and identifying the IP multicast group assigned to each identified channel".

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has

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been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

d. No Reasonable Expectation of Success

The Office Action recites, regarding combining applied portions of Rogers and Day, at Pages 3-4, "it would have been obvious to an artisan to apply Day's teaching to Roger's system with the motivation being to enable user to access or schedule a multimedia data presentation in a more efficient and reliable manner"

One skilled in the art would not have a reasonable expectation of success regarding this combination. Specifically, Rogers states, at col. 9, lines 34-49:

[a] TV tuner board 464 can also be provided within broadband data switch 450 for connection to a cable television source. The input broadcast television signal is split into 5 separate signals, one for each tuner. In various embodiments, TV tuner board includes a signal splitter and 5 separate TV tuners each of which can independently tune to a different channel based on commands received from controller unit 457. These commands can be generated by individual users at teleconferencing stations such as those shown in FIG. 3. The TV signals can be forwarded to individual user's desktops over existing telephone lines through modem/duplexers 451 through 453. This allows each user to watch a broadcast or cable TV program at his desk over existing telephone lines and tune to any of various stations.

Day states, at col. 5, lines 48-65:

[n]etwork implementation 40 of the present invention can be used to deliver real-time (streamed) video/audio to any network-connected clients, including those on the Internet or an intranet, using standard LAN technology with TCP/IP and FTP. An Internet 'web browser' can be used to select a video for viewing (such as a short clip or commercials, or a full-length film). A variety of encoding formats

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can be supported for delivery of video streams, including RTP, TCP, HTTP and IP multicast. A presentation formatter server can provide presentation format pages to initiate a common gateway interface (CGI) program used to facilitate client requests. The presentation formats might include specific video selection (where the name or other access parameter of a desired file is already known), video-on-demand (allowing a client to select an asset from a dynamically generated list), and joining multicast sessions (previously scheduled video broadcasts to a group of clients, such as students enrolled in a distance-learning class).

No substantial evidence is presented that one skilled in the art as of 24 April 2001 would have found that the "TV tuner board 464" of Rogers would be able to recognize or operatively utilize "video streams, including RTP, TCP, HTTP and IP multicast" "formats" or "standard LAN technology with TCP/IP and FTP".

Thus, one skilled in the art would not have had a reasonable expectation of success in combining the applied portions of Rogers with the applied portions of Day to arrive at the claimed subject matter of claim 25.

e. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

f. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day and Rogers, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 25, in such a

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manner so as to arrive at the claimed subject matter of claim 25. Regarding the proffered combination of Day and Rogers the present Office Action states, at Pages 3 and 4 "it would have been obvious to an artisan to apply Day's teaching to Roger's system with the motivation being to enable user to access or schedule a multimedia data presentation in a more efficient and reliable manner."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

g. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 25 is respectfully requested. Reconsideration of each of claims 26-45, each of which ultimately depends from claim 25 is also respectfully requested.

2. Claim 26

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 26, in such a manner so as to arrive at the claimed subject matter of claim 26. Regarding the proffered combination of Day, Rogers, and DeSimone the present Office Action states, at Page 11 "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system to provide conference over IP."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the

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known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 26 is respectfully requested.

3. Claim 27

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 27 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein the identifying of one or more available channels identifies less than all of the available channels". Instead, Rogers allegedly illustrates, at Fig. 7a, step 703, "USER SELECTS A PROGRAM (SEND TO SWITCH)". Applicant respectfully submits that a "user" that "selects a program" that is sent "to switch" does not teach "wherein the identifying of one or more available channels identifies less than all of the available channels"

The applied portions of Day fail to cure at least these deficiencies of the applied portions of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 27, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

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c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Day no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 27 in such a manner so as to arrive at the claimed subject matter of claim 27.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 27 is respectfully requested.

4. Claim 28

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 28, in such a manner so as to arrive at the claimed subject matter of claim 28. Regarding the proffered combination of Day, Rogers, and Hari the present Office Action states, at Page 7, "it would have been obvious to an artisan to apply Hari's teaching Rogers's system with the motivation being to provide one user requesting a video."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

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For at least these reasons, a reconsideration and withdrawal of the rejection of claim 28 is respectfully requested.

5. Claim 29

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 29 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein available channels are provided to the computer system by receiving from a plurality of content providers indications of **channels** that are made available by each content provider". Instead, Rogers allegedly illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. **PROGRAMS**". Applicant respectfully submits that the applied portion of Rogers is silent regarding a "content provider". Accordingly, Applicant submits that Rogers does not teach, "wherein available channels are provided to the computer system by receiving from a plurality of content providers indications of channels that are made available by each content provider". The applied portions of Day fail to cure at least these deficiencies of the applied portions of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 29, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

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c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Day no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 29 in such a manner so as to arrive at the claimed subject matter of claim 29.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 29 is respectfully requested.

6. Claim 30

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 30 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Kalva teach, "wherein an indication that a channel is made available by a content provider is sent using a session announcement protocol". Applicant respectfully submits that the applied portion of Kalva does not even mention a "session announcement protocol".

The applied portions of the remaining relied upon references fail to cure at least these deficiencies of the applied portions of Kalva.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 30, and consequently the Office Action fails to establish a *prima facie* case of obviousness.

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Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 30, in such a manner so as to arrive at the claimed subject matter of claim 30. Regarding the proffered combination of Day, Rogers, and Hari the present Office Action states, at Page 8, "it would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to provide a user the flexibility of selecting the content as well as scheduling the program that the user wants to watch without disturbed."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 30 is respectfully requested.

7. Claim 31

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the

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applied portions of the relied-upon references, that are used in rejecting claim 31, in such a manner so as to arrive at the claimed subject matter of claim 31. Regarding the proffered combination of Day, Rogers, and Hari the present Office Action states, at Page 9, "it would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to provide a user the flexibility of selecting the content as well as scheduling the program that the user wants to watch without disturbed."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 31 is respectfully requested.

8. Claim 32

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 32, in such a manner so as to arrive at the claimed subject matter of claim 32. Regarding the proffered combination of Day, Rogers, and DeSimone the present Office Action states, at Page 11 "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide real time interactive distribution of multimedia information using the multicast IP service."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is

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presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 32 is respectfully requested.

9. Claim 33

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and Alexanders, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 33, in such a manner so as to arrive at the claimed subject matter of claim 33. Regarding the proffered combination of Day, Rogers, and Alexanders the present Office Action states, at Page 6, "it would have been obvious to provide data over ATM network unicastly."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 33 is respectfully requested.

10. Claim 34

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

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b. Missing Claim Limitations

Claim 34 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon reference teaches, "wherein the channel source address is an ATM virtual path and transmission circuit".

The present Office Action alleges this claimed subject matter is taught by Alexanders at col. 2, lines 40-44. Yet this applied portion of Alexanders states, "[t]he source LEC can then use the ATM address to establish a connection to unicast data to the destination, a so-called data direct Virtual Channel Connection (VCC), and transmit its data to the destination thereon." Applicant respectfully submits that the present Office Action presents no evidence that the one having ordinary skill in the art would construe the term "channel" as claimed in claim 34 to have the same meaning as the word "channel" in the applied portion of Alexander would have to one having ordinary skill in the art.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 34, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and Alexanders, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 34, in

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such a manner so as to arrive at the claimed subject matter of claim 34. Regarding the proffered combination of Day, Rogers, and Alexanders the present Office Action states, at Page 6, "it would have been obvious to provide data over ATM network unicastly."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 34 is respectfully requested.

11. Claim 35

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 35, in such a manner so as to arrive at the claimed subject matter of claim 35. Regarding the proffered combination of Day, Rogers, and DeSimone the present Office Action states, at Page 12, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide a conference to only the requested client."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*.

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Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 35 is respectfully requested.

12. Claim 36

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Day no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 36 in such a manner so as to arrive at the claimed subject matter of claim 36.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 36 is respectfully requested.

13. Claim 37

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

Claim 37 states, *inter alia*, "wherein the subscriber unit is connected to the computer system via a DSL connection."

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day and Rogers, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 37, in such a manner so as to arrive at the claimed subject matter of claim 37. Regarding the proffered combination of Day and Rogers the present Office Action states, at Page 9, "it would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to provide a user the flexibility of selecting the content as well as scheduling the program that the user wants to watch without disturbed."

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Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a “rational underpinning, to combine the known elements in the fashion claimed in the patent at issue”. Moreover, no evidence is presented that this unsupported assertion was “known in the prior art”, as required by *KSR*. Applicant reiterates that under *KSR* “rejections on obviousness grounds cannot be sustained by mere conclusory statements”.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 37 is respectfully requested.

14. Claim 38

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 38 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, “wherein an available channel is a channel whose data is currently being multicasted”. The present Office Action attempts, at Page 5, to apply a nonexistent portion of Rogers in the rejection of claim 38 (“page 310, right column, second paragraph”). Applicant respectfully submits that the present Office Action fails to provide any evidence that any applied portion of any relied upon reference teaches “wherein an available channel is a channel whose data is currently being multicasted”.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 38, and consequently the Office Action fails to establish a *prima facie* case of obviousness.

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Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Day no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 38 in such a manner so as to arrive at the claimed subject matter of claim 38.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 38 is respectfully requested.

15. Claim 39

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. See MPEP 707.07(d). For example, claim 39 states, *inter alia*, yet the present Office Action fails to even allege that any applied portion of any relied upon reference teaches, "wherein the subscriber is identified using a media access control address".

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as

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attempted to be modified and/or combined, expressly or inherently teach every limitation of claim 39, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 39, in such a manner so as to arrive at the claimed subject matter of claim 39. Regarding the proffered combination of Day, Rogers, and DeSimone the present Office Action states, at Page 11 "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system to provide conference over IP."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 39 is respectfully requested.

16. Claim 40

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

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b. Missing Claim Limitations

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). For example, claim 40 states, *inter alia*, yet the present Office Action fails to even allege that any applied portion of any relied upon reference teaches, “wherein the subscriber is identified using an IP address”.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 40, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 40, in such a manner so as to arrive at the claimed subject matter of claim 40. Regarding the proffered combination of Day, Rogers, and DeSimone the present Office Action states, at Page 11 “it would have been obvious to an artisan to apply DeSimone’s teaching to Rogers’s system to provide conference over IP.”

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a “rational underpinning, to combine the known elements in the fashion claimed in the patent at issue”. Moreover, no evidence is

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presented that this unsupported assertion was “known in the prior art”, as required by *KSR*. Applicant reiterates that under *KSR* “rejections on obviousness grounds cannot be sustained by mere conclusory statements”.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 40 is respectfully requested.

17. Claim 41

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 41 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, “providing a subscribed channel list for the subscriber that indicates channels which the subscriber is permitted to access”. Instead, Rogers allegedly illustrates, at Fig. 7a, step 702, “SWITCH SENDS LIST OF AVAIL. PROGRAMS” (emphasis added). Applicant respectfully submits that a “list” of “programs” does not teach “channel list” according to how the word “channel” would be construed “in light of the specification” “by one of ordinary skill in the art”. Moreover, the applied portion of Rogers is silent regarding any “subscribed” “list” whatsoever.

The applied portions of Day fail to cure at least these deficiencies of the applied portions of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, expressly or inherently teach every limitation of

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claim 41, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Day no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 41 in such a manner so as to arrive at the claimed subject matter of claim 41.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 41 is respectfully requested.

18. Claim 42

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 42 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein data for a channel is received at the computer system and forwarded to the subscriber unit". Instead, Rogers allegedly illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. PROGRAMS" (emphasis added). Applicant respectfully submits that a "list" of "programs" does not teach a "channel" according to how the word "channel" would be construed "in light of the specification" "by one of ordinary skill in the art".

The applied portions of Day fail to cure at least these deficiencies of the applied portions of Rogers.

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Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 42, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Day no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 42 in such a manner so as to arrive at the claimed subject matter of claim 42.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 42 is respectfully requested.

19. Claim 43

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and Acharya, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 43, in such a manner so as to arrive at the claimed subject matter of claim 43. Regarding the proffered combination of Day, Rogers, and Acharya the present Office Action states, at Page 13, "it would

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have been obvious to an artisan to apply Acharya's teaching to Rogers's system with the motivation being to provide transmits data as a series of variable length packets, each having a circuit number that identifies its source and destination address."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 43 is respectfully requested.

20. Claim 44

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 44, in such a manner so as to arrive at the claimed subject matter of claim 44. Regarding the proffered combination of Day, Rogers, and DeSimone the present Office Action states, at Page 12, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide a conference to only the requested client."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

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For at least these reasons, a reconsideration and withdrawal of the rejection of claim 44 is respectfully requested.

21. Claim 45

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 45 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein the request is sent in response to the subscriber requesting to view the list". Since claim 45 depends from claim 25, "the list" is a "list of available channels". Instead of teaching this claimed subject matter, the applied portion of Rogers allegedly illustrates, at Fig. 7a, step 706, "SELECTED PROGRAM DISPLAYED IN WINDOW" (emphasis added). Applicant respectfully submits that a "program" as recited in step 706 does not teach a "list of available channels".

The applied portions of Day fail to cure at least these deficiencies of the applied portions of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 45, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

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c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Day no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 45 in such a manner so as to arrive at the claimed subject matter of claim 45.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 45 is respectfully requested.

22. Claim 46

a. Inherency

The present Office Action states, regarding Rogers, that "receiving from a subscriber unit a request for a list of available channels (programs), the request including information identifying a subscriber (fig. 7a, step 701, the identity of the subscriber is inherent in the request so that the server could be able to send back a list of available program-emphasis added)." *See*, Page 3. No evidence has been presented that the admittedly "missing descriptive material is 'necessarily present'" in Rogers. Applicant respectfully requests provision of evidence supporting the assertion that "receiving from a subscriber unit a request for a list of available channels (programs), the request including information identifying a subscriber (fig. 7a, step 701, the identity of the subscriber is inherent in the request so that the server could be able to send back a list of available program-emphasis added)."

To the extent that the present Office Action or any future Office Action intends to rely on inherency to support a claim rejection, Applicant respectfully traverses, respectfully requests provision of proper evidence supporting such rejection, and respectfully requests a detailed explanation of how the "missing descriptive material is necessarily present, not merely probably or possibly present", in any prior art reference cited to support such rejection.

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b. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

c. Missing Claim Limitations

Claim 46 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "receiving from a subscriber unit a request for **a list of available channels**, the request including information identifying a subscriber and being sent using HTTP protocol". Instead, Rogers allegedly illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. PROGRAMS" (emphasis added). Applicant respectfully submits that no evidence is presented that a "list" of "programs" teaches "a list of available channels" according to how the word "channel" would be construed "in light of the specification" "by one of ordinary skill in the art".

The applied portions of Day fail to cure at least these deficiencies of the applied portions of Rogers.

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. See MPEP 707.07(d). For example, claim 46 states, *inter alia*, yet the present Office Action fails to even allege that any applied portion of any relied upon reference teaches, "sending to the subscriber unit a response with an indication of the identified channels, **the response being sent using HTTP protocol**".

In addition, as amended, claim 46 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "the response managed via IP multicast capable TCP/IP software".

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of

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the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

d. No Reasonable Expectation of Success

The Office Action recites, regarding combining applied portions of Rogers and Day, at Pages 3-4, "it would have been obvious to an artisan to apply Day's teaching to Roger's system with the motivation being to enable user to access or schedule a multimedia data presentation in a more efficient and reliable manner"

One skilled in the art would not have a reasonable expectation of success regarding this combination. Specifically, Rogers states, at col. 9, lines 34-49:

[a] TV tuner board 464 can also be provided within broadband data switch 450 for connection to a cable television source. The input broadcast television signal is split into 5 separate signals, one for each tuner. In various embodiments, TV tuner board includes a signal splitter and 5 separate TV tuners each of which can independently tune to a different channel based on commands received from controller unit 457. These commands can be generated by individual users at teleconferencing stations such as those shown in FIG. 3. The TV signals can be forwarded to individual user's desktops over existing telephone lines through modem/duplexers 451 through 453. This allows each user to watch a broadcast or cable TV program at his desk over existing telephone lines and tune to any of various stations.

Day states, at col. 5, lines 48-65:

[n]etwork implementation 40 of the present invention can be used to deliver real-time (streamed) video/audio to any network-connected clients, including those on the Internet or an intranet, using standard LAN technology with TCP/IP and FTP. An Internet 'web browser' can be used to select a video for viewing (such as a short clip or commercials, or a full-length film). A variety of encoding formats can be supported for delivery of video streams, including RTP, TCP, HTTP and IP multicast. A presentation formatter server can provide presentation format

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pages to initiate a common gateway interface (CGI) program used to facilitate client requests. The presentation formats might include specific video selection (where the name or other access parameter of a desired file is already known), video-on-demand (allowing a client to select an asset from a dynamically generated list), and joining multicast sessions (previously scheduled video broadcasts to a group of clients, such as students enrolled in a distance-learning class).

The present Office Action presents no evidence that one having ordinary skill in the art would have found that the "TV tuner board 464" of Rogers would be able to recognize or operatively utilize "video streams, including RTP, TCP, HTTP and IP multicast" "formats" or "standard LAN technology with TCP/IP and FTP".

Thus, one skilled in the art would not have had a reasonable expectation of success in combining the applied portions of Rogers with the applied portions of Day to arrive at the claimed subject matter of claim 46.

e. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

f. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day and Rogers, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are, used in rejecting claim 46, in such a manner so as to arrive at the claimed subject matter of claim 46. Regarding the proffered combination of Day and Rogers the present Office Action states, at Pages 3 and 4 "it would have

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been obvious to an artisan to apply Day's teaching to Roger's system with the motivation being to enable user to access or schedule a multimedia data presentation in a more efficient and reliable manner."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

g. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 46 is respectfully requested. Reconsideration of each of claims 47-57, each of which ultimately depends from claim 46 is also respectfully requested.

23. Claim 47

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 47 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein the identifying of one or more available channels identifies less than all of the available channels". Instead, Rogers allegedly illustrates, at Fig. 7a, step 703, "USER SELECTS A PROGRAM (SEND TO SWITCH)". Applicant respectfully submits that a "user" that "selects a program" that is sent "to switch" does not teach "wherein the identifying of one or more available channels identifies less than all of the available channels"

The applied portions of Day fail to cure at least these deficiencies of the applied portions of Rogers.

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Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 47, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Day no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 47 in such a manner so as to arrive at the claimed subject matter of claim 47.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 47 is respectfully requested.

24. Claim 48

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 48, in such a manner so as to arrive at the claimed subject matter of claim 48. Regarding the proffered combination of Day, Rogers, and Hari the present Office Action states, at Pages 7-8, "it would have been obvious to an artisan to apply Hari's teaching Rogers's system with the motivation being to provide one user requesting a video."

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Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 48 is respectfully requested.

25. Claim 49

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 49 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein available channels are provided to the computer system by receiving from a plurality of content providers **indications of channels that are made available by each content provider**". Instead, Rogers allegedly illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. PROGRAMS". Applicant respectfully submits that the applied portion of Rogers is silent regarding a "content provider". Accordingly, Applicant submits that Rogers does not teach, "wherein available channels are provided to the computer system by receiving from a plurality of content providers **indications of channels that are made available by each content provider**". The applied portions of Day fail to cure at least these deficiencies of the applied portions of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as

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attempted to be modified and/or combined, expressly or inherently teach every limitation of claim 49, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Day no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 49 in such a manner so as to arrive at the claimed subject matter of claim 49.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 49 is respectfully requested.

26. Claim 50

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Day no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 50 in such a manner so as to arrive at the claimed subject matter of claim 50.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 50 is respectfully requested.

27. Claim 51

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

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Claim 51 states, *inter alia*, "wherein the subscriber unit is connected to the computer system via a DSL connection."

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Day, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 51, in such a manner so as to arrive at the claimed subject matter of claim 51. Regarding the proffered combination of Day, Rogers, and Hari the present Office Action states, at Page 9, "it would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to provide a user the flexibility of selecting the content as well as scheduling the program that the user wants to watch without disturbed." As a substantive matter, Applicant respectfully submits that this unfounded assertion appears to have no relevance to the claimed subject matter.

Also, Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion was "known in the prior art", as required by *KSR*. Applicant reiterates that under *KSR* "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 51 is respectfully requested.

28. Claim 52

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

The Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d). For example, claim 52 states, *inter alia*, yet the present